

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number: 19797-0005001
I hereby certify that this correspondence is being filed with the United States Patent and Trademark Office via the Electronic Filing System (EFS) on the date shown below.  <u>August 14, 2008</u> Date of Deposit  <u>/Thomas H. Reger II/</u> Signature  <u>Thomas H. Reger II</u> Typed or Printed Name of Person Signing Certificate	Application Number  10/624,860	Filed  July 21, 2003
	First Named Inventor  Hu, et al.	
	Art Unit  2129	Examiner  Peter D. Coughlan
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a Notice of Appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s).          Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest.          See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record <u>47,892</u>          (Reg. No.)</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.          Registration number if acting under 37 CFR 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.</p> <p><input checked="" type="checkbox"/> Total of 4 forms are submitted.</p>		

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Hu, et al.	Art Unit :	2129
Serial No. :	10/624,860	Examiner :	Peter D. Coughlan
Filed :	July 21, 2003	Conf. No. :	6527
Title :	BUSINESS SOLUTION MANAGEMENT (BSM)		

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ARGUMENTS

This Pre-Appeal Brief is being filed pursuant to the Pre-Appeal Brief Conference Pilot Program and is responsive to the final Office Action mailed March 26, 2008 ("Office Action"), and the Advisory Action mailed July 14, 2008 ("Advisory Action"), in which all pending Claims 1-3 and 5-31 were rejected. A Notice of Appeal accompanies this submission

**I. SECTION 112 REJECTIONS**

Claims 1, 3, 7, 15, 20, 21, 25, and 28-30 stand finally rejected for allegedly failing to comply with the enablement requirement of § 112, ¶ 1.<sup>1</sup> The test for enablement is whether "one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." M.P.E.P. § 2164.01 (quoting *U.S. v. Telectronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988)). Appellants respectfully submit that one of ordinary skill in the art could make and use the invention claimed and described in the present Application without undue experimentation, as set forth below.

First, with respect to "technology objects," the Office Action suggests that there is "no explanation what is a 'technology object.'" Office Action at 3. Appellants disagree because the Application provides that "[a] Technology Object Management function 524 may include standard pre-defined and pre-configured BSM technology objects 314 (Figs. 3A-3B), creation of new technology objects, and management of technology objects and instantiations." Application at [00281]. The technology objects 314 include several different categories of technology objects, such as "generic component objects," "generic integration objects," "solution component

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<sup>1</sup> The Office Action withdraws the previous written description rejections under 35 U.S.C. § 112, ¶ 1. See Office Action at 37.

objects,” “solution configuration objects,” and “solution integration objects.”<sup>2</sup>

The Office Action next improperly limits the breadth of the claims by suggesting examples of business solution management systems directed to “manufacturing processes or solving abstract problems such as an algorithm for solving N-P complete problems.” Office Action at 3. Such examples are neither recited in the claims nor required by the applicable patent laws or M.P.E.P. The Office Action further suggests that there “exists no working examples within the specification which clarifies [sic] how ‘technology objects’ are to be employed.” Office Action at 4. Notwithstanding that the M.P.E.P. expressly instructs that “[t]he specification need not contain an example if the invention is otherwise disclosed in such manner that one skilled in the art will be able to practice it without an undue amount of experimentation,” M.P.E.P. § 2164.02, Appellants respectfully suggest that the Office Action ignores portions of the Application that provide examples of the employment of “technology objects.” See Application at [0053].<sup>3</sup>

In short, the Office Action’s rejection of Claims 1, 3, 7, 15, 20, 21, 25, and 28-30 under § 112 cannot withstand scrutiny when the express disclosure of the Application demonstrates that “one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation,” M.P.E.P. § 2164.01. For at least the foregoing reasons, Appellants request the § 112, ¶ 1 rejections be overturned.

## II. SECTION 101 REJECTIONS

Claims 1-3 and 5-31 stand finally rejected under 35 U.S.C. § 101 for containing nonstatutory subject matter. But as Appellants previously submitted, the M.P.E.P. makes clear that “a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure’s functionality to be realized, and is thus statutory.”

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<sup>2</sup> See *id.* at [00282]-[00286]. See also Application at [00288] (“A ‘technology object’ exists for each technology component and each configuration structure in the architectural landscape. The attributes for the components/structures are captured within the technology object. Thus, the technology object clearly describes the functionality and its purpose in the architecture, as well as other specific information.”). See Application at [0053].

<sup>3</sup> In other words, one embodiment of the invention described clearly indicates that in accordance with “an object-oriented concept,” components of the business solution management system, including technology components and solutions, may be instantiated as “technology object” types in order to describe such components and solutions.

M.P.E.P. § 2106.01(I). In accordance with the M.P.E.P.'s instruction, Claim 1 recites "software comprising instructions stored in a computer readable medium."

Further, the present Application indicates, for example, that a "business solution" addresses or resolves internal and external business issues, and as a result, *promotes growth and success of a business enterprise*." Application at [0003]. Appellants respectfully submit that such a practical purpose, namely, promoting growth of a business enterprise by resolving issues encountered by the enterprise, satisfies the M.P.E.P. and § 101's requirement for a "practical purpose."<sup>4</sup> Based on the foregoing, the invention, which is defined in the claims, has a well-established and immediately apparent utility. Thus, Appellants submit that the rejections of Claims 1-3 and 5-31 under § 101 are improper and should be overturned.<sup>5</sup>

### III. SECTION 102 REJECTION

Claim 29 stands finally rejected under 35 U.S.C. § 102(b) as being anticipated by "*UML Distilled: A Brief Guide to the Standard Object Modeling Language*" by Fowler ("Fowler"). But Fowler fails to teach or suggest each element of Claim 29 as required, such as "prompting the user to select at least one instantiated business process object and one instantiated technology object." The Office Action at page 7 relies on Fowler's disclosure of a "structural feature" and a "behavioral feature" to reject the claimed instantiated technology object and instantiated business process object, respectively. Fowler describes "structural" and "behavioral features" in the

<sup>4</sup> Regardless of the Application's disclosure, amendments made to Claims 1, 25, and 29 further provide for a practical application with a useful, concrete, and tangible result. The patent laws define patentable subject matter as "any new and useful process, machine, manufacture or composition of matter, or any new and useful improvement thereto." 35 U.S.C. § 101. When an abstract idea is reduced to a practical application, the abstract idea no longer stands alone if the practical application of the abstract idea produces a useful, concrete and tangible result and satisfies the requirements of 35 U.S.C. § 101. See *In re Alappat*, 33 F.3d 1526 (Fed. Cir. 1994); *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1375 (Fed. Cir. 1998). Thus, producing a useful, concrete, and tangible result is the key to patentability according to *State Street* and other applicable case law. Appellants respectfully submit that, for example, Claim 1 produces a useful, concrete, and tangible result via "persisting the modified business solution for subsequent presentation through a graphical user interface."

<sup>5</sup> The Office Action also maintains the previous objection to the use of permissive language, such as the word "may" in describing certain aspects of the subject matter within the specification. See Office Action at 5. The use of this term in the specification merely indicates that the described embodiments serve as examples - it is the claims that set forth the "invention." For example, the term "may" has been used in the present Application in the same manner as in numerous issued patents; see e.g., U.S. Patent No. 6,339,832 to Bowman ("*Bowman*") at 2:25-27. Thus, use of the term "may" does not create a problem under § 101 in the present Application and Appellants request that all rejections or assertions based on this incorrect proposition be withdrawn.

context of a UML meta-model, *i.e.*, a diagram that describes a notation. *See id.* at 4, Fig. 1-1.<sup>6</sup> Appellants respectfully submit that neither the description of the UML meta-model in *Fowler*, nor the figure illustrating such a meta-model, teach, suggest, or describe a "business process object" or a "technology object," instantiated or otherwise, and the Office Action fails to show how such "features" suggest the foregoing claimed object-oriented structures.

*Fowler* further fails to teach "maintaining and modifying the business solution," as recited by Claim 29. The Office Action at page 11 asserts that "objects that are set up and then left alone" in *Fowler*, thereby disclosing "maintaining and modifying the business solution." Putting aside that there is no indication that the features (the so-called "objects") in *Fowler* are analogous to the claimed "business solution," *Fowler* expressly notes that objects are "not modified often, and when they are, we can create them again." *Fowler* at 8 (emphasis added). In short, rather than teaching that the business solution may be modified as the Office Action asserts, *Fowler* indicates that the few objects that are modified are created anew.<sup>7</sup> For at least the foregoing reasons, Appellants respectfully request the rejection of Claim 29 in view of *Fowler* be overturned and that this claim and those depending therefrom be allowed.<sup>8</sup>

#### IV. SECTION 103 REJECTIONS

Claims 1 and 25 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over *Fowler* in view of U.S. Patent Publication No. 2002/0174005 to Chappel ("*Chappel*"). But *Chappel* fails to account for the deficiencies in *Fowler* described above with regard to certain aspects in Claims 1 and 25, which are analogous to those in Claim 29, such as "business process objects" and "technology objects." *Chappel* describes a use of statistical modeling and rules-based analysis methods to plan a business operation. *See Chappel* at [0020]-[0021]. *Chappel*

<sup>6</sup> Appellants respectfully traverse the Office Action's assertion that the "software" of Appellants, as recited in Claims 1 and 25, is equivalent to the Unified Modeling Language (UML). *See Office Action* at 8. Appellants submit that UML is not software but a standardized specification language for object modeling used, for example, to create an abstract model of a system.

<sup>7</sup> The Advisory Action states that "there is no basis that the Applicant's [sic] argument that [*Fowler*] can not be used for designing a business solution." *Advisory Action* at 2. This position, which essentially requires the Appellants' to disprove the theory that *Fowler* can be used "for designing a business solution," is in contravention to: (1) the language of § 102, which places the burden on the Patent Office to show that an applicant is not entitled to a patent; and (2) the requirement that a single § 102 reference show "each and every element as set forth in the claim." M.P.E.P. § 2131.

<sup>8</sup> Further, Appellants dispute the Office Action's assertion that claims may be interpreted in their broadest reasonable sense. *See Office Action* at 41, ¶ 13. It is well established that claims must be read in "light of the specification as it would be interpreted by one of ordinary skill in the art." M.P.E.P. § 2111.

further describes two databases, a source database 140 and rules database 145, to store business data and predetermined rules, respectively. *See id.* at [0026]. The Office Action seems to compare *Chappel's* source database 140 and rules database 145 to the claimed first and second data repositories, respectively. But *Chappel's* mere showing of some database, indeed even two databases, simply does not address the full language of the claimed repositories, namely, "a first data repository comprising the instantiated user-selectable, pre-defined business objects" and "a second data repository comprising the instantiated user-selectable, pre-defined technology objects," as recited by example Claim 1. Accordingly, Appellants respectfully request that the rejections of Claims 1 and 25 and all claims depending therefrom be overturned.

#### CONCLUSION

For the reasons above, Appellants respectfully submit that the present claims are allowable over the §§ 101, 102, 103, and 112 rejections. Reversal of the rejections is respectfully requested. If questions remain, please contact the undersigned attorney.

The Appeal fee in the amount of \$510 is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization to Deposit Account No. 06-1050. A Petition for a One Month Extension pursuant to 37 C.F.R. § 1.136 along with the required fee is submitted concurrently herewith. Appellants believe that no additional fees are due. However, if this is incorrect, please charge such fees or credit any overpayments to deposit account 06-1050, referencing the attorney docket number shown above.

Respectfully submitted,

Date: August 14, 2008

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